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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/736,047

12/15/2003

Jacob A. Flagle

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4057

7590

02/25/2008

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

02/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,047	<b>Applicant(s)</b> FLAGLE ET AL.	
	<b>Examiner</b> JONATHAN ML FOREMAN	<b>Art Unit</b> 3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 – 6 and 8 - 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 – 6 and 8 - 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 6 and 8 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2004/0087876 to Eskuri in view of U.S. Patent No. 5,303,714 to Abele et al.

In regards to claims 1 – 6 and 8 - 27, Eskuri discloses an elongate member (Figure 1) having a proximal end (20), a main body having a first diameter, a distal end comprising an elongate tip (22) having a second uniform diameter [0017], and a single taper portion [0019] disposed directly between the main body and a distal end and defining a first taper between the first and second diameters [0017] [0018]; and a coating having at least a partial exterior [0022] – [0024] comprising a solid flexible tip formed of a biocompatible material having a length axially extending beyond the distal end, the ratio of the length to the first diameter being greater than 3:1 and between 12:1 and 250:1 [0018][0028][0029], the length of the solid flexible tip extends axially beyond the elongate tip of the distal end approximately equal to or greater than a longitudinal length of the elongate tip [0020][0028][0029], the coating having a proximal portion and a distal portion, the proximal portion commencing within the taper portion of the elongate member (Figure 1). However, Eskuri fails to disclose a partial exterior of the coating having a second taper that approximates the first taper of the taper portion. Abele et al. disclose a guidewire having a coating forming a flexible tip (24), wherein at least a portion of the partial exterior of the coating has a constant diameter or a second

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taper that approximates the first taper of a tapered portion (Figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coating as disclosed by Eskuri to include a second taper that approximates the first taper of a tapered portion as taught by Abele et al. in order to achieve a desired flexibility at the distal tip and to allow the elongate member to move freely throughout the vasculature of a patient (Col. 3, line 62 – Col. 4, line 26). The coating disclosed by Eskuri is a blend of polymers [0024]. Eskuri discloses the length of the flexible tip being greater than 3mm [0028][0029]. The elongate member is either stainless steel or nitinol [0016]. A lubricious coating is disposed on a portion of the main body [0030]. The flexible tip comprises radiopaque material [0026]. A solid marker is disposed in the flexible tip and a portion of the coating is disposed between the distal end of the elongate member [0026] and provides localized weight to the flexible tip. The flexible tip comprises a curvilinear distal portion [0023]. The flexible tip includes an opacifying agent [0026].

### ***Response to Arguments***

3. Applicant's arguments filed 12/5/07 have been fully considered but they are not persuasive. Applicant asserts that one skilled in the art would not combine Eskuri with Abele et al. to create the claimed invention. However, the Examiner disagrees. Abele et al. teach that having a tapered tip allows for penetration into and movement through an occlusion. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a taper as taught by Abele et al. in order to allow the elongate member to move freely throughout the vasculature of a patient (Col. 3, line 62 – Col. 4, line 26). Additionally, the tapering allows for a more flexible distal tip which would facilitate travel along body lumens while not causing trauma to the lumen walls. Applicant asserts that Eskuri does not disclose a longitudinal length of an elongate tip of a distal end or the length of a solid flexible tip that extends beyond the elongate tip. However,

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Eskuri discloses an elongate tip having a length of 3 cm [0020]. Eskuri teaches the flexible tip having a length of 1000 [0029] multiplied by 0.03 inches [0029]. The Examiner considers the coating to be solid. Furthermore, Eskuri teaches cylindrical elements being "tightly packed" [0028][0029], which is also considered by the Examiner to be solid.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736